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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,758	04/14/2005	Rachel Ancliff	P33126USw	5647

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

NOTIFICATION DATE	DELIVERY MODE
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03/27/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/531,758	Applicant(s) ANCLIFF ET AL.	
	Examiner Brenda L. Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 12-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1, 12-19 and 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/14/05, 11/15/06, 11/15/06 & 3/12/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 and 12-29 are pending in the application.

Election/Restrictions

1. Applicant's election without traverse of Group I in the reply filed on January 3, 2008 is acknowledged.

Specification

2. The disclosure is objected to because of the following informalities: pages 5, 14, 20, 27 and 45 are missing and there is a blank page between pages 41 and 42.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 22, 25 and 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The scope of the method claims is not adequately enabled solely based on histamine H3 receptor activity provided in the specification.

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In evaluating the enablement question, several factors are to be considered. In re Wands, 8 USPQ2d 1400 (Fed. Cir. 1988); Ex parte Forman, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

The nature of the instant invention has claims, which embrace substituted piperazine compounds.

HOW TO USE: Claims 22, 25 and 28 are to a method for treating any and all diseases and/or conditions associated histamine H3 receptor activity. Any evidence presented must be commensurate in scope with the claims and must clearly demonstrate the effectiveness of the claimed compounds. The scope of claims 22, 25 and 28 includes diseases and/or conditions not even known at this time, which may be associated with histamine H3 receptor activity. While the treatment of allergic rhinitis have been linked with histamine H3 receptor activity the art does not recognize use of such inhibitors as broad based drugs for treating all disorders instantly embraced. It is difficult to treat many of the disorders claimed herein.

No screening protocol(s) are ever described. Thus, no evidence of in vitro effectiveness is seen in the specification for one of the instantly claimed substituted piperazine compounds. In general, pharmacological activity is a very unpredictable area. In cases involving physiological activity "the scope of the enablement obviously varies inversely with the degree of unpredictability of the

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factors involved." *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970). Since this case involves unpredictable in-vivo physiological activities, the scope of the enablement given in the disclosure presented here was found to be low.

Where the utility is unusual or difficult to treat or speculative, the examiner has authority to require evidence that tests relied upon are reasonably predictive of in vivo efficacy by those skilled in the art. See *In re Ruskin*, 148 USPQ 221; *Ex parte Jovanovics*, 211 USPQ 907; MPEP 2164.05(a).

Patent Protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. Tossing out the mere germ of an idea does not constitute enabling disclosure. *Genentech Inc. v. Novo Nordisk* 42 USPQ2d 1001.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 12-19 and 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a. Claims 1, 12-19 and 21-29 are vague and indefinite in that it is not known what is meant by the variable R_1 which is not defined within the claim.

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- b. Claims 1, 12-19 and 21-29 are vague and indefinite in that it is not known what is meant by the definition of R^1 where there is no variable R^1 within the compounds of formula (I).
- c. Claims 1, 16-19 and 21-29 are vague and indefinite in that it is not known what is meant by the moiety C_1 alkenyl in the definition of R^1 .
- d. Claims 1, 16-19 and 21-29 are vague and indefinite in that it is not known what is meant by the moiety C_1 alkenoxy in the definition of R^1 .
- e. Claims 1, 16-19 and 21-29 are vague and indefinite in that it is not known what is meant by "optionally substituted by C_{1-6} alkyl, halogen or C_{1-6} alkyl C_{1-6} alkoxy" on the moiety $-CONR^{15}R^{16}$ within the definition of R^1 .

Allowable Subject Matter

5. Claim 20 is allowed. None of the prior art of record or a search in the pertinent art area teaches the species as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information

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for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/
Primary Examiner, Art Unit 1624